



UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Cohn, et al.
Filed : December 31, 2003
Serial No. : 10/749,436
For : Methods and Compositions for Reducing or
Eliminating Post-Surgical Adhesion Formation
Group Art Unit : 1616
Examiner : E. Webman

Commissioner for Patents
Mailstop Non-fee Amendment
P.O. Box 1450
Alexandria, Virginia 22313-1450

SIR:

Election of Invention in Response to Restriction Requirement

In response to the Examiner's restriction requirement in the above-referenced patent application, Applicant provisionally elects with traverse to prosecute the invention set forth in Group II, claims 67-82 and 86-92 which is drawn to polymeric compositions which are to be used *inter alia* in reducing or preventing adhesions in a patient. These claims are primarily directed to polymeric composition species comprised of A blocks which are polylactic acid polyesters and B blocks which are (poly)ethylene oxide, further end-capped with an alkyl group (preferably a methyl group) which are chain-extended with diisocyanates to form coupled polymeric blocks as otherwise presented in claims 93-100 in the amendment attached hereto. New claims 93-100 are readable on the elected species.

Notwithstanding Applicants election, Applicants respectfully traverse the Examiner's requirement for restriction. Applicants respectfully submits that prosecution of the originally filed group II claims should not be restricted to the elected species. It is respectfully submitted that the group II invention (claims 67-82 and 86-92) are directed to compositions which are sufficiently narrow to allow examination of all the claims within this group in an efficient manner.

According to M.P.E.P. §803, restriction by the Examiner of patentably distinct inventions is proper if the claimed inventions are independent and a serious burden would be placed on the

Examiner if restriction was not required. Applicant respectfully submits that the presentation of the originally filed claims in group I would not place such a serious burden on the Examiner as to require restriction. All of the originally filed claims are related, though patentably distinct compositions for reducing and/or eliminating adhesion.

Although the claimed compositions which may be used in such methods are generally patentably distinct from each other, Applicants respectfully submit that any search the Examiner would need to conduct in examining the instant application set forth in original claims 67-82 and 86-92, as well as new claims 93-100 would not be unduly burdensome. Moreover, the examination of claims 67-82 and 86-100 would not place such a serious burden on the Examiner as to require restriction.

Applicants understand the general policy considerations for the Patent Office's requirement for restriction in certain instances. In this instance, however, those considerations do not weigh in favor of restricting the inventions here. In determining the appropriateness of restriction, one must also consider the countervailing consideration that, in each instance, Applicant wishes the Patent Office to examine his or her application with a certain degree of "judicial efficiency" and wishes to have patent claims issue which reflect the breadth of his or her invention. The balance that is to be weighed should be tipped in this instance by the fact that the claimed compositions set forth in claims 67-82 and 86-92 are sufficiently narrow to weigh on the side of examining all the claims in group II.

Applicants respectfully submit that the originally filed claims in group II (67-82 and 86-92) and new claims 93-100 are sufficiently narrow to allow the Examiner to determine patentability without being subjected to the serious burden referred to in M.P.E.P. §803. Consequently, Applicant respectfully requests that the Examiner withdraw the species restriction requirement and examine all of the claims in group II, namely claims 67-82 and 86-100.

Respectfully submitted,

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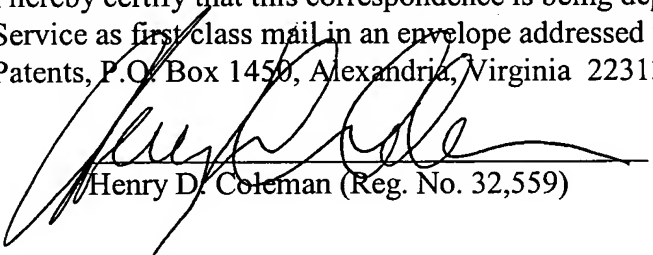
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Dated: July 6, 2005

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Amendment/Response

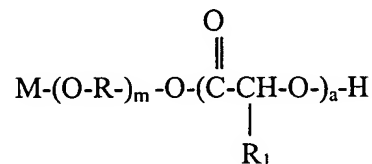
In response to the Examiner's restriction requirement of May 6, 2005, and before consideration of Applicant's response to that restriction requirement, Applicants respectfully request that the instant application be amended as follows.

In the Claims:

Cancel claims 1-66 and 83-85 and amend the remaining claims 67-82 and 86-92 as follows. Claims 67-82 and 86-92 remain in the application as originally filed pending the outcome of the Examiner's decision on the enclosed response to the outstanding restriction requirement. Claims 93-100 are new and are based on original claims 83-85, except that the A block is now represented by a C₂-C₆ ester group. Support for the A block being variable can be found *inter alia* in the specification at page 4, top and bottom, page 5, first paragraph, page 13, in the definition of "polyester" and in original claims 83-85.

1-66. Cancelled.

1. (Original) A composition for use in reducing or preventing adhesions in a patient comprising a polymer of the chemical structure:



where m and a are positive integers,